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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,296	11/25/2003	Mary Beth Boyette		4133

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EXAMINER

FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,296

Applicant(s)

BOYETTE, MARY BETH

Examiner

David T. Fidei

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8, 9 and 11 are finally rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 8 one end of the handle is recited as attached to the top perimeter, the opposite end of the handle is attached to the bottom perimeter of the holder. In figure 1 of the present invention the handle 20 is shown as attached to the top perimeter of the holder along what appears to be a top seam 32. Nowhere in the specification is anything shown or described where an opposite end of the handle 20 is attached to the bottom perimeter at the bottom of the holder at an opposite seam.

As to claim 9, the handle is shown as attached to the left outer perimeter in figure 1 and an opposite end attached at the right outer perimeter of the holder. Nowhere in the specification is anything shown or described where handle 20 has either of the ends attached to the center.

As claim 11, nowhere in the specification is the handle shown or described as attached to one corner of the side perimeter, the opposite end of the handle attached to the opposite corner of the side perimeter.

3. Claims 8, 9 and 11 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As explained in the previous paragraph the specification does not describe or show a

Art Unit: 3728

handle the it attached in the all the forms claimed, e.g., one end of the handle attached to the top perimeter with the opposite end of the handle is attached to the bottom perimeter of the holder. Thus one skilled in the art would not have found the present disclosure enabling for the claimed subject matter, but would have to look outside the disclosure, e.g., for a teaching of a handle having one attached to the top perimeter with the opposite end of the handle is attached to the bottom perimeter of the holder such as shown by Magyar Patent no. 3,134,416 where in figure 1 either of the handles 16 and 19 of Magyar have one end of (e.g., leg 17) attached to the top perimeter 11 with an opposite end attached to the bottom perimeter 12.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites a multi-eyeglass holder "allowing items contained within to be extracted without disturbing position of said holder". However, it is not known what the scope and content of this language is, nor is it clear what defined thereby that distinguishes over other equivalent holders. All that is gleaned from the disclosure, as originally filed, seems to be the pocket being open at one end simply permits sliding of eyeglasses or other items in or out, e.g., page 3, line 3 of the original disclosure.

As to claims 8, 9 and 11, since the handle construction is not described or shown with all its forms, it is unclear what this language embodies. As noted above, the prior art handle of Magyar teaches leg portions 17, 18, 20 and 21 flared and attached in such a manner where the handle can be characterized as having one end attached to the top perimeter with the opposite end attached to the bottom perimeter of the holder.

Claims 8-15, recite as in claim 7 but it is unclear what is as in claim 7.

Art Unit: 3728

Also, “the length” of said handle, “the length” of said holder, “the opposite end” of said handle, “the bottom” perimeter of said holder, “the width” of said holder, “the center”, “the ends” of said handle of claims 8-10 has no antecedent basis.

The examiner’s reviewing authority has stated that the second paragraph of 35 U.S.C. 112 requires a claim to particularly point out and distinctly claim the subject matter which applicant regards as his or her invention. Under *In re Hammack*, 166 USPQ 204 (CCPA 1970) and *In re Moore*, 169 USPQ 236 (CCPA 1971), claims must be analyzed to determine their metes and bounds so that it is clear from the claim language what subject matter the claims encompass. This analysis must be performed in light of the applicable prior art and the disclosure. The definiteness of the claims is important to allow others who wish to enter the market place to ascertain the boundaries of protection that are provided by the claims. *Ex parte Kristensen*, 10 USPQ 2d 1701, 1703 (PTO Bd. Pat. App. & Intf. 1989).

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the handle attached as explained above with respect to claims 8, 9 and 11 should have been shown in the drawings as originally filed. Since this action is being made final, the features can be canceled from the claims or the required traversed by petition. The canceling claims 8, 9 and 11 would only remove the objection by the Examiner to the drawings and the above rejection. However, the application has other rejections that would not place the application in condition for allowance.

The objection to the drawings cannot be held in abeyance.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Magyar (Patent no. 3,134,416). A holder is disclosed comprising a body 10 with a handle 16, 19 containing a plurality of compartments 28 closed on one end, open on the opposite end whereby the open end of the compartment are unobstructed, allowing items contained within that manifestly appears to be capable of extraction without disturbing the position of said holder.

9. Claims 7 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Corpman (Patent no. 770,354). A holder is disclosed comprising a body, with a handle 14, containing a plurality of compartments 5 closed on one end, open on the opposite end whereby the open end of the compartment are unobstructed, allowing items contained within that manifestly appears to be capable of extraction without disturbing the position of said holder.

As to claims 12 and 15, the open end of the compartments are located on the top, also considered a side, perimeter of the holder. The intended use language whereby items can be extracted while said holder is rolled in tubular position is of no patent significance over that structure shown by Corpman. A reference that contains all the structure defined in a claim, but not the recited use anticipates the claim because a new use does not make an old product patentable, *In re Schreiber*, 128 F.3d 1473, 44 U.S.P.Q.2d 1429 (Fed. Cir. 1997).

As to claims 13 and 15, the open end of the compartments are located on a top, also considered a side, perimeter of the holder.

As to claim

10. Claims 7 and 10-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Blackman (Patent no. 5,002,401). A holder is disclosed comprising a body 1, with a handle 16, containing a plurality of compartments 52, 54, 56, 58 closed on one end, open on the opposite end whereby the open end of the compartment are unobstructed, allowing items contained within to be extracted without disturbing the position of said holder, see col. 5, lines 54-56.

Art Unit: 3728

As to claim 10, the length of the handle 16 is considered such that it can be wrapped around the holder when in the tube position in that the drawstring can be gathered, tied in a knot, so that it is "wrapped around" the holder to the extent claimed

As to claim 11, the handle 16 is considered attached to one corner of the side perimeter, the opposite end of the handle attached to the opposite corner of the side perimeter as defined by channel 136 meeting at edge seam 115 and opposite seam 36.

As to claims 12-15, the compartments have open ends that are located on the top, also considered a side, perimeter of the holder where articles can be withdrawn while the holder is rolled in the tubular position by loosening the handle 16, see col. 5, lines 54 to col. 6, line 5.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magyar (Patent no. 3,134,416). The difference between claims 8-10 and Magyar (Patent no. 3,134,416) is the length of the handle, i.e., the length of the handle is the length of the holder (claim 8), the length of the handle is the same as the width of the holder (claim 9) or the length of the handle is sufficient to wrap around the holder when in the tube position (claim 10).

It would have been an obvious matter of design choice to make the handle of any length desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative

Art Unit: 3728

dimensions, the claimed device was not patentably distinct from the prior art device, *Gardner v. TED Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. § 2144.04 IV.

12. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blackman (Patent no. 5,002,401). The difference between claims 8-10 and Blackman is the length of the handle, i.e., the length of the handle is the length of the holder (claim 8), the length of the handle is the same as the width of the holder (claim 9) or the length of the handle is sufficient to wrap around the holder when in the tube position (claim 10 to the extent that Blackman is not of such a length).

It would have been an obvious matter of design choice to make the handle of any length desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In *re Rose*, 105 USPQ 237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative dimensions, the claimed device was not patentably distinct from the prior art device, *Gardner v. TED Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. § 2144.04 IV.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3728

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the Examiner concerning the merits of the claims should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei
Primary Examiner
Art Unit 3728

dtf
August 8, 2005